

REMARKS/ARGUMENTS

Claims 1-16 are pending in this application. Claims 2,3,5 and 7-15 are withdrawn from consideration as being drawn to a non-elected invention. Claim 16 is allowed and claims 1, 4 and 6 are objected to.

The Examiner has requested restriction among the following groups.

- I. Claims 1,4,6 (in part), and claim 16, are drawn process of preparing a compound of formula I and the compound of formula II, classified in various subclasses of classes 544, 546 and 548.
- II. Claim 2 drawn to a different process for preparing a compound of formula I, classified in various subclasses of classes 544, 546 and 548.
- III. Claims 3,5,7,9, drawn to a different process of preparing a compound of formula I, classified in various subclasses of classes 544, 546 and 548.
- IV. Claim 10, drawn to a compound of formula XI, classified in various subclasses of 564, 544, 546, 548.
- V. Claim 11, drawn to a compound of formula XII, classified in various subclasses of class 544, 546, and 548.
- VI. Claim 12, drawn to a compound of formula XI, classified in various subclasses of class 564, 544, 546, 548.
- VII. Claim 13, drawn to a compound of formula XII, classified in various subclasses of classes 544, 546, and 548.
- VIII. Claim 14, drawn to a process for preparing a compound of formula XIII, classified in various subclasses of classes 544, 546, and 548.
- IX. Claim 15, drawn to a process for preparing a compound of formula XI, classified in various subclasses of classes 564, 544, 546, and 548.

During a telephone conversation with applicant's representative, Ellen Coletti, on June 29, 2004, an election was made with traverse to prosecute Group I, i.e. claims 1,4,6 (in part), 16 and the species 2 in claim 16. Applicants hereby affirm this election.

The present invention relates to a process for preparing tetrasubstituted imidazole derivatives of the general formula (I) and to a process for preparing the compound of formula (II). The process is described in detail on page 8, 9 and 13-18 of the specification. Claims 1-9 and 12-15 are process claims; claims 10, 11 and 16 are compound claims. Claim 1 is drawn to a multi-step process for preparing a compound of formula (I) and claims 4, 5, 6, 7, 8 and 9 are all dependent claims. The Examiner has inadvertently characterized claims 12 and 13 as compound claims when in fact they are process claims.

In requesting restriction, the Examiner has concluded that claims 1,2 and 3 are directed to two different processes for preparing compounds of formula (I) when in fact, claims 2 and 3 claim different steps in the multi-step process of claim 1. In the process of claim 1 the starting material is a compound of formula (VIII) and the intermediate compounds along the way to formula (I) are (X), (XI), (XII), (XIII) and (XIV). Claim 2 claims the same process for preparing a compound of formula (I) however the process starts with the intermediate compound of formula (XI) and then follows the procedure claimed in claim 1 for the preparation of a compound of formula (I). Claim 3 claims the same process for preparing a compound of formula (I) in which the process starts with the intermediate compound of formula (XII) and then follows the same procedure claimed in claim 1 to prepare a compound of formula (I). Claims 4-9 are all dependent upon claim 1 or claim 3 and claim the use of a specific reactant in the process or the preparation of a specific compound. Claims 2 and 3, therefore, claim a process for making a compound of formula (I) which is the same process claimed in claim 1 but each claim begins with a different step in the multi-step process of claim 1. All of the claims, i.e. 1-9, claim the same process. Claims 1-9 are not patentably distinct one from the other and should, therefore, be examined in the same application. The fact that the subject matter of Group I-III is classified in the same subclasses, i.e. 544, 546 and 548 is another indication of the similarity of the subject matter. Reconsideration of the restriction requirement as it applies to claims 1-9 is courteously requested.

Claims 10 and 11 claim the intermediate compounds of the formula (XI) and (XII) respectively, while claims 12 and 13 claim a process for preparing the compounds of formula (XI) and (XII) respectively. Claims 14 and 15 are drawn to a process for preparing a compound of formula (XIII) and (XI) respectively. Claim 14 encompasses the step in the process of claim 1 for making the intermediate compound of formula (XIII) while claim 15 encompasses the step in the process of claim 1 for preparing the intermediate compound of formula (XI) wherein R₃ is as defined. All of the processes and compounds claimed in Groups IV-IX are related to the process of Group I. It is submitted, therefore, that all of the claims should be examined in the same application.

Reconsideration of the restriction requirement is courteously requested.

By the present amendment claim 1 has been amended to conform to the scope of the elected subject matter as determined by the Examiner. Applicants reserve the right to file a divisional application on the non-elected subject matter. The amendment to claim 1 is believed to remove the objection to claims 1, 4 and 6.


Claim 16, which is drawn to a crystalline form of the compound of formula (II), has been found allowable. The Examiner has pointed out that claim 8 of U.S. patent No. 5,965,583 anticipates the elected species. Claim 8 of the '583 patent claims, among others, the compound 4-(4-fluorophenyl)-2-(4-

hydroxybutyn-1-yl)-1-(3-phenylpropyl)-5-(4-pyridinyl)imidazole. Applicants wish to point out that recrystallization of the compound of formula (I) yields one of two crystalline forms referred to in the specification as Form A and Form B. (See page 18 of the specification at lines 20-26.) Applicants have claimed the crystalline form designated as form B. This can be seen by the x-ray diffraction data given in claim 16 which corresponds to the x-ray diffraction data found for Form B on page 20 of the specification. There is no recognition of the two crystalline forms for the compound of Formula (II) in the '583 patent. No x-ray diffraction data are given for the compound of Form B in the '583 patent (see Example 4). It is submitted, therefore, that claim 8 of the '583 patent does not anticipate the elected species.

In view of the above discussion and the amendments herein being made to the claims, it is believed that all of the objections and rejections have been removed.

Applicant respectfully requests that a timely Notice of Allowance be issued in this application.

Respectfully submitted,



John W. Harbour
Reg. No. 31,365
Attorney for Applicants

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-2169